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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,543	10/19/2005	Jean Pierre Luttringer	4-22874/A/PCT	6027

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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EXAMINER

NGUYEN, TRI V

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,543

Applicant(s)

LUTTRINGER ET AL.

Examiner

Tri V. Nguyen

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/07 has been entered.

Response to Amendment & Arguments

2. There were no amendments to the claims. The currently pending claims considered below are Claims 1-10.

3. Claims 1-10 stand rejected under 103(a) Hildebrand 942, Hildebrand 924, Sieber 786 and Sieber 536 as set forth in the office action dated 05/09/2007.

4. The examiner would like to thank applicants for the clarifications of the declaration under 37 CFR 1.132 filed 04/20/07. At the onset, the examiner remarks that the standard deviations are not provided in the showing; however, the examiner assumes that the results provided are statistically significant. Upon further review of the declaration, the examiner notes that:

(a) the showing is not commensurate with the instant claims - recall that the showing is directed to a combination of the specific species (1a), (2a), (3a1) and (3b1) while the instant claims are directed to the genera;

(b) the compositions with component (3a1) have not be considered since they are directed to a non-elected specie;

(c) the composition with species (2a) + (3a1) does not show unexpected results as ΔE^* for the composition is higher than for the single component (2a) - it seems like the composition is

the result of the average of the single components which is an expected result;

(d) the composition with species (1a) + (3a1) shows convincing unexpected result as the ΔE^* is lower than either of the single components - the examiner remarks that amended claims directed to the specific composition of (1a) + (3a1) would not be taught or suggested in the recited prior art.

In response to applicant's argument concerning improper motivation to combine references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, the examiner asserts that it is not necessary that a reference actually suggest changes or possible improvements which the applicant made, as stated in In re Sheckler, 168 USPQ 716 (CCPA 1971). The Patent & Trademark Office can satisfy the burden under § 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 USPQ2d 1596, 1598 (CA FC 1988). Therefore, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). In particular, the examiner remarks that the Hildebrand references suggest the addition of additional colorants and mixing various dyes to obtain the desired color ('924: page 7, parag. 2 and page 12 parag. 2 and '942: page 8, parag. 6). It would have been obvious to the skilled artisan to achieve the composition, as the references teach each of the claimed ingredients for the same utility and such modifications are recognized as being well within the purview of the skilled artisan to yield predictable results.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-6 and 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hildebrand 942 or Hildebrand 924 in view of Sieber 786.

Hildebrand 942 and 924 disclose a method for dyeing fibre material and plastics using a composition including disperse dye (1a) (Hildebrand 924: page 1, parag 1 and 5, formula 2 on page 3 and Hildebrand 942: formula (2) on page 3) and disperse dye (2a) (Hildebrand 924: formula (11) and (14) on page 8; formula (25) on page 11 and Hildebrand 942: formula (11) on page 9, (14) on page 10 and (25) on page 12). In the analogous dyeing art, Sieber 786 discloses the nickel complex of formula (3b) (page 3, formula (I)).

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, see *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

7. Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hildebrand 942 or Hildebrand 924 and Sieber 786 as applied to claim 1 above, and further in view of Sieber 536.

Hildebrand 942, Hildebrand 924 and Sieber 786 teach the dye composition of claim 1 but do not explicitly disclose the pigment of formula (4). In the analogous dyeing art, Sieber 536 discloses the pigment of formula (4) (page 4, formula (I)).

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, see *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Conclusion

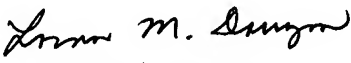
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NVT

NVT
11/9/2007


LORNA M. DOUYON
PRIMARY EXAMINER